

### **REMARKS**

The applicants originally submitted claims 1-9 in this application. In responses to previous Office Actions, the applicants amended claims 1, 2, 4, 5 and 7, canceled claim 9, and added a new claim 10. In this amendment, the applicants have amended claim 1. Accordingly, claims 1-8 and 10 remain pending in this application.

The Examiner rejected claims 1, 3-6 and 8 under 35 U.S.C. §103(a) as being unpatentable over Backer et al. (U.S. Patent No. 5,180,411) in view of Tuminaro (U.S. Patent No. 6,496,627) or Lemaire et al. (U.S. Patent No. 5,478,371). The applicants respectfully traverse the rejection in view of the claim amendment set forth above and the remarks set forth below.

The applicants have now amended claim 1 to recite that the fiber is exposed to deuterium at room temperature and at a partial pressure between approximately 0.01 and 0.05 atmospheres. Support for the amendment is found in the applicants' specification, e.g., at paragraphs [0013] and [0044].

None of the cited references, which suggest deuterium exposure, disclose or suggest deuterium exposure at room temperature and at a partial pressure of between approximately 0.01 and 0.05 atmospheres. Tuminaro does not mention any deuterium partial pressure other than to say the deuterium partial pressure is "predetermined." The Lemaire et al. reference discloses deuterium exposure at pressures in the range of 14-11,000 pounds per square inch (psi) - *i.e.*, between approximately 1 and 750 atmospheres. Such partial pressures are well outside applicants' partial pressure range.

Therefore, the applicants respectfully submit that neither the Backer et al. reference in combination with Tuminaro nor the Backer et al. reference in combination with the Lemaire et al. reference discloses or suggests the applicants' invention as recited in claim 1, as amended. More specifically, nothing in Backer et al. in view of Tuminaro or Backer et al. in view of Lemaire et al. discloses or suggests deuterium exposure at room temperature and at a partial pressure between approximately 0.01 and 0.05 atmospheres. Accordingly, the applicants respectfully submit that the Examiner withdraw the

rejection of claims 1, 3-6 and 8 under 35 U.S.C. §103(a) over Backer et al. in view of Tuminaro or Lemaire et al.

The Examiner rejected claims 1 and 7 under 35 U.S.C. §103(a) as being unpatentable over Oyobe et al. (U.S. Patent No. 5,262,365) in view of Tuminaro (or Lemaire et al.) and Baumgart (U.S. Patent No. 4,820,322). The applicants respectfully traverse the rejection in view of the claim amendment set forth above and the remarks set forth below.

The Examiner states that the Oyobe et al. reference does not teach exposing the drawn fiber to deuterium at room temperature. Also, as discussed hereinabove, neither the Tuminaro reference nor the Lemaire et al. reference disclose or suggest deuterium exposure at room temperature and at a partial pressure between approximately 0.01 and 0.05 atmospheres. Therefore, the combination of the Oyobe et al. reference with either the Tuminaro reference or the Lemaire et al. reference does not disclose or suggest the applicants' invention as recited in claim 1, as amended. Baumgart, which is cited for its disclosure of overcladding a fiber preform, does not cure the deficiencies of Oyobe et al. in combination with Tuminaro or Lemaire et al. with respect to the applicants' invention as recited in the claim 1, as amended. Accordingly, the applicants respectfully request that the Examiner withdraw the rejection of claims 1 and 7 under 35 U.S.C. §103(a) over Oyobe et al. in view of Tuminaro (or Lemaire et al.) and Baumgart.

As discussed hereinabove, none of the cited art discloses or suggests the applicants' invention as recited in the claims as amended. Nonetheless, the applicants still maintain that they were diligent in reducing their invention to practice from the May 31, 2000 date of conception to at least January 26, 2001, the date on which the applicants submitted the invention to the attorney who drafted the patent application. The evidence submitted previously clearly shows a pattern of continuous work over the entire period from the date of conception to the date the inventors submitted the invention to the drafting attorney.

The applicants respectfully note that the applicants' invention was conceived and reduced to practice during the course of the inventors'

employment with the assignee. Therefore, it is not unreasonable to expect that the inventors had to attend to other employment tasks, during the time of reduction to practice, that may have prevented them from formally documenting their reduction to practice during the alleged gaps in the timeline. In view of this and other considerations, the applicants respectfully submit that the alleged timeline gaps set forth by the Examiner are not enough to conclude that diligence has not been shown. Moreover, the applicants respectfully remind the Examiner that one of the inventors has submitted a signed affidavit in which he declares, to the best of his ability, that he was diligent in reducing the invention to practice from the date of conception to at least the date when the inventors submitted the invention to the attorney who drafted the patent application.

Also, in response to the Examiner's suggestion that the attorney who drafted the patent application was not diligent, the applicants submit herewith a second affidavit by John M. Harman, a registered attorney of record who drafted the applicants' patent application. The affidavit states that Mr. Harman had a reasonable backlog of unrelated cases to prepare during the time period in which he was drafting applicants' patent application and that he worked on the applicants' patent application expeditiously, given the backlog of cases that he had to prepare. Moreover, the affidavit states that during the same time period, Lucent Technologies Inc. (Lucent) was engaged in the sale of its Optical Fiber Solutions business unit and that Mr. Harman was involved in negotiations that included the review of approximately 900 of Lucent's patents and patent applications (and their foreign counterparts) that ultimately would be transferred to the purchaser of the business unit. The business unit was sold on November 16, 2001 to Fitel USA Corp. In view of this affidavit, the applicants respectfully submit that Mr. John M. Harman was diligent in drafting the applicants' patent application.

The Examiner indicated that the terminal disclaimer filed on October 31, 2005, disclaiming the terminal portion of any patent granted on this application that would extend beyond the expiration date of US Patent No. 6,776,012 has


been accepted. The applicants thank the Examiner for the acceptance of this terminal disclaimer.

The Examiner indicated that claims 2 and 10 are allowable. The applicants thank the Examiner for indication of the allowable subject matter. However, both claims 2 and 10 depend from claim 1, which is allowable, as discussed hereinabove.

The applicants submit that all claims now are in condition for allowance, and respectfully urge that they be allowed and the application passed to issue. If the Examiner disagrees, the Examiner is invited to call the attorney for the applicants at the telephone number provided below.

Respectfully,

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